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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,303	06/23/2000	Scott Lorenz	5053-36000	1772

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EXAMINER
BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 11/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 June 2000</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-22</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

   If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____ .

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

   a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.

DETAILED ACTION

Notice to Applicant

1.   This communication is in response to the application filed 23 June 2000. Claims

1-22 are pending. The IDS statement filed 21 December 2001 has been entered and

considered.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

3.   Claims 16-22 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Under the statute, the claimed invention must

fall into one of the four recognized statutory classes on invention, namely, a process (or

method); a machine (or system); an article of manufacture; or a composition of matter.

(A) Claims 16-22 appear to be directed toward a carrier medium comprising program

instructions, wherein the program instructions are computer-executable to implement a

series of steps. However, it is unclear as to which recognized statutory class of

invention the carrier medium of claim 16 is directed. In particular, a carrier medium is

not a process or method as it lacks a series of steps. A carrier medium is not a

machine or system as there is no specific recitation of machine or system components.

A carrier medium is not recognized as a composition of matter. A carrier medium, per se, is merely a data structure.

Under the guidance of recent case law, the requirements of 35 U.S.C. 101 are met when "the practical application of the abstract idea produces a useful, concrete, and tangible result" (State Street Bank & Trust Co. vs. Signature Financial Group, Inc., 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998)). However, the claims, as presently recited, do not appear to have a tangible result. Data structures or computer programs, in general, that are not claimed as embodied in computer-readable media are descriptive material per se, and are not statutory because they are not capable of causing a functional change in a computer.

In particular, it is unclear whether the program instructions, as recited in claims 16-22, are embodied on a specific readable medium within the technological arts (and thus tangible). Such claimed instructions do not define any structural or functional interrelationships between the program instructions and carrier medium, which permit the purpose of the instructions to be realized (see MPEP section 2106 IV, B, 1, (a) for further guidance). Simply stated, how are the claimed program instructions tangibly embodied within the carrier medium?

In light of the above, it is respectfully submitted that the claimed invention, although useful and concrete, it not tangible, and thus fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C. 101.

(B) Claims 17-22 incorporate the deficiencies of claim 16 through dependency, and are

therefore, rejected as well.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) do not apply to the examination of this application as the application

being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

published under 35 U.S.C. 122(b). Therefore, this application is examined under 35

U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5.   Claims 1-2, 6-7, 9-10, 12-14, 16-17, and 19-21 are rejected under 35

U.S.C. 102(e) as being anticipated by Borghesi et al. (5,950,169).

(A) As per claim 1, Borghesi discloses a system for managing insurance claim

processing comprising:

        (a) a communication server for insurance claim management comprising a

processor coupled to memory, wherein the memory is embodied as a mass storage

device and storing a program constructed using known software tools and languages,

wherein the program is used to (col. 5 line 50 to col. 6 line 13, col. 7 line 54 to col. 8

line 2, col. 10 lines 50-56, and col. 20 lines 33-50):

transmitting, from a remote computer, a predetermined amount of data related to

calculate a total loss valuation to the server, wherein the data is input by a user through

a user interface (col. 21 lines 29-35 and col. 23 lines 17-34);

(b) at least one remote computer terminal comprising a processor coupled to

memory, wherein the memory is embodied as a mass storage device and storing a

program constructed using known software tools and languages, wherein the program

is used to (col. 5 line 50 to col. 6 line 13, col. 7 line 54 to col. 8 line 2, col. 10 lines 50-

56, and col. 20 lines 33-50):

inputting and outputting data pertaining to an insurance claim through a graphical

user interface (col. 23 lines 17-34); and

sending an insurance claim data file over a network to the communication server,

wherein the data file contains data on the insured, data on a claim, and data on

satisfying a claim (col. 20 line 55 to col. 21 line 17 and col. 22 lines 19-40).

(B) As per claim 2, Borghesi discloses the insurance claim data file comprising data

gathered concerning the extent of damage or injury suffered by the insured, insurance

claim settlement information including data on satisfying a claim such as estimates and

a total loss calculation for a claim (col. 2 lines 50-59, col. 5 lines 5-15, col. 22 lines 54-

63, and col. 23 lines 4-16).

(C) As per claim 6, Borghesi discloses the server and remote computer terminals

format and send data over a network using TCP/IP (Fig. 2 and col. 11 lines 44-52).

(D) As per claim 7, Borghesi discloses at least one remote computer and a network

connecting the computers to a server (Fig. 2 and col. 20 lines 33-50). The remainder of

claim 7 repeats the same limitations of claim 1, specifically with regards to the steps

performed using the apparatus of claims 1, and therefore claim 7 is rejected for the

same reasons given above for claim 1, and incorporated herein.

(E) Method claims 9-10 and 12-14 repeat the subject matter of system claims 1-2 and

6, respectively, as a series of steps rather than as a set of apparatus elements. As the

underlying apparatus elements of claims 1-2 and 6 have been shown to be fully

disclosed by the teachings of Borghesi in the above rejections of claims 1-2 and 6, it is

readily apparent that the method disclosed by Borghesi includes the steps performed by

the apparatus. As such, these limitations are rejected for the same reasons given

above for method claims 1-2 and 6, and incorporated herein.

(F) Claims 16-17 and 19-21 repeat the subject matter of system claims 1-2 and 6,

respectively, as a carrier medium comprising computer instructions to carry out the

functionality of the system from method claims 1-2 and 6. As the underlying apparatus

elements of claims 1-2 and 6 have been shown to be fully disclosed by the teachings of

Borghesi in the above rejections of claims 1-2 and 6, it is readily apparent that the

programs embodied in a mass storage device or memory of a computer (col. 5 line 50

to col. 6 line 13, col. 7 line 54 to col. 8 line 2, col. 10 lines 50-56, and col. 20 lines 33-

50) disclosed by Borghesi provides the means to carry out the functions of the system.

As such, these limitations are rejected for the same reasons given above for method

claims 1-2 and 6, and incorporated herein.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Borghesi et al. (5,950,169) as applied to claim 1, and further in view of McKee et al.

(6,272,482) and Walker et al. (6,119,093).

(A) As per claims 3 and 4, the relevant teachings of Borghesi are as discussed in the

rejections above, and incorporated herein.

Borghesi fails to expressly disclose a rules engine. McKee includes an expert

business system, including a knowledge base and an inference engine, relying on a

large number of business rules applied to insurance claims and losses (col. 1 lines 5-36

and line 58 to col. 2 line 7 and col. 4 line 24 to col. 5 line 30). At the time the invention

was made, it would have been obvious to a person of ordinary skill in the art to include

the aforementioned features of McKee within the system of Borghesi with the motivation

of assisting an insurance company, in particular in claims processing, in making various

business decisions by automatically implementing established procedures of the

company (McKee; col. 1 lines 37-47).

Borghesi and McKee fail to expressly disclose a web server, a web browser, and

web pages comprising insurance claim assessment questions. However, Borghesi

includes remote computer terminals in communication with a communication server

over a communications line, such as telephone lines or wireless communications

facilities, or a network, wherein the communication is provided over a general wide area

network provider such as America Online ™ (AOL) (col. 5 line 50 to col. 6 line 5).

Furthermore, Borghesi includes a user interface for managing insurance claims and

communicating with the server using TCP/IP, wherein the interface displays information

for creating or editing an estimate including changing estimate lines within the estimate,

and identifying other charges such as towing or storage fees (Fig. 9-12, col. 11 lines 44-

51 and col. 23 lines 16-34). It is noted that the information displayed in Borghesi's

interface such as identifying charges is considered to be a form of a question relating to

claim assessment. Walker discloses accessing and browsing a website through a

conventional user interface (reads on "browser"), wherein a server transmits policy

information over the Internet which is posted on a website (reads on "web server"), and

wherein a policy holder is able to submit a claim via the website (Fig. 1, col. 4 line 47 to

col. 5 line 8, and col. 13 line 52 to col. 14 line 52). At the time the invention was made,

it would have been obvious to a person of ordinary skill in the art to include the

aforementioned components of Walker within the method taught collectively by

Borghesi and McKee with the motivation of increasing the ease of access to information

and calculations from a remote computer (Borghesi; Fig. 3 and col. 10 lines 28-45).

8.   Claims 5, 8, 11, 15, 18, and 22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Borghesi et al. (5,950,169) as applied to claims 1, 9, and 16.

(A) As per claim 5, 11, and 18 the relevant teachings of Borghesi are as discussed in

the rejections above, and incorporated herein.

Borghesi fails to expressly disclose the network comprising the Internet and the

Internet protocols including HTTP. However, Borghesi includes remote computer

terminals in communication with a communication server over a communications line,

such as telephone lines or wireless communications facilities, or a network, wherein the

communication is provided over a general wide area network provider such as America

Online ™ (AOL) (col. 5 line 50 to col. 6 line 5). Furthermore, Borghesi includes a user

interface for managing insurance claims and communicating with the server using

TCP/IP (col. 11 lines 44-51 and col. 23 lines 16-34). It is noted that AOL as disclosed

by Borghesi is considered to be a form of the Internet and when communicating

information from a server to a browser over the Internet, the protocol almost universally

used is HTTP, and the skilled artisan would have found it an obvious modification to

include communicating using the Internet and HTTP within the system taught by

Borghesi with the motivation of increasing the ease of access to information and

calculations from a remote computer (Borghesi; Fig. 3 and col. 10 lines 28-45) including

reducing the time to access information.

(B) As per claims 8, 15, and 22, the relevant teachings of Borghesi are as discussed in

the rejections above, and incorporated herein.

Borghesi discloses an insurance claim data file comprising data gathered

concerning the extent of damage or injury suffered by the insured, insurance claim

settlement information including data on satisfying a claim such as estimates and a

total loss calculation for a claim (col. 2 lines 50-59, col. 5 lines 5-15, col. 22 lines 54-63,

and col. 23 lines 4-16). Borghesi also includes repairing the damaged object (col. 15

lines 64 to col. 16 lines 22). Borghesi fails to expressly disclose the one or more

treatments of bodily injuries. However, it is respectfully considered that repairing a

damaged object is considered a form of treatment to fix the damaged object. The

skilled artisan would have found it an obvious modification to include treatments of

bodily injury within the system of Borghesi with the motivation of efficiently managing an

insurance claim workflow by performing, evaluating, and documenting all tasks when

processing a claim (Borghesi; col. 2 lines 20-30).

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to the

Applicant's disclosure. The cited but not applied prior art teaches a computerized

insurance premium quote request and policy issuance system (4,831,526), an auto

repair estimate, text, and graphic system (5,432,904), a system and method for the

creation of an adjudicated settlement transaction at a point of service (6,208,973), and a

claims processing system for electronically reviewing and adjudicating medical

insurance claims (6,343,271).

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-

3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm,

and from 8:30am – 5:00pm on alternate Fridays.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas can be reached at (703) 305-9588.

        Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the Receptionist whose telephone number is (703)

306-1113.

11.   **Any response to this action should be mailed to:**

                Commissioner of Patents and Trademarks
                Washington, D.C. 20231

Or faxed to:

(703) 305-7687   [Official communications; including After Final
                   communications labeled "Box AF"]

(703) 746-8374   [Informal/ Draft communications, labeled
                   "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th Floor (Receptionist).

CB
CB
November 19, 2002

DINH X. NGUYEN
PRIMARY EXAMINER